



Express Mail No.: EV475168646 US  
Date of Deposit: January 13, 2006

Attorney Docket No. 23906-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Peter Elms et al.  
Serial No.: 10/743,321  
Filed: December 23, 2003  
For: SECURE ELECTRONIC REGISTRATION AND VOTING SOLUTION  
Examiner: Sheikh, A.  
Art Unit: 2131

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

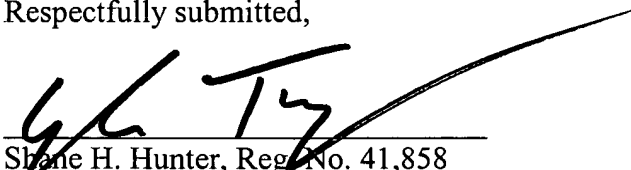
**TRANSMITTAL LETTER**

Transmitted herewith for filing in the above-identified application are the following documents:

1. Statement under 37 CFR 1.47(a) and Request to Withdraw Grant of Petition under 37 CFR 1.47(a) (3 pages);
2. Exhibit A: Declaration of Peter Elms under 37 CFR 1.47(a) (3 pages);  
Exhibit B: Combined Declaration/Power of Attorney (2 pages);  
Exhibit C: Petition under 37 CFR 1.47(a) (2 pages);  
Exhibit D: Declaration in Support of Petition under 37 CFR 1.47(a) (3 pages);  
Exhibit E: Letter dated June 9, 2004 from James Gatto (Mintz Levin) to Celine Crowson (Hogan & Hartson) (2 pages); and
3. Return Postcard.

If the enclosed papers are considered incomplete, the Mail Room is respectfully requested to contact the undersigned at 617-542-6000. The Director is hereby authorized to charge any fees associated with the present submission which may be required, or credit any overpayment, to Deposit Account 50-0311, Reference No. 23906-002. A duplicate copy of this Transmittal Letter is enclosed.

Respectfully submitted,

  
Shane H. Hunter, Reg. No. 41,858  
Kyle Turley, Reg. No. 57,197  
Attorneys for Applicants  
Mintz, Levin, Cohn, Ferris,  
Glovsky and Popeo, P.C.  
Tel.: 617/348-1765  
Fax: 617/ 542-2241  
Customer No. 30623

Date: January 13, 2006



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter Elms et al.  
Serial No.: 10/743,321  
Filed: December 23, 2003  
For: SECURE ELECTRONIC REGISTRATION AND VOTING SOLUTION  
Examiner: Sheikh, A.  
Art Unit: 2131

---

Mail Stop Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

STATEMENT UNDER 37 CFR 1.47(a) AND REQUEST TO WITHDRAW  
GRANT OF PETITION UNDER 37 CFR 1.47(a)

Pursuant to 37 CFR 1.47(a) and in response to the Patent Office's invitation in a letter dated June 16, 2005, Mr. Peter Elms submits this correspondence, and the enclosed Declaration (Ex. A), to make his position of record in this application (the Application). Mr. Elms respectfully requests that the granting of the Request for Reconsideration of Petition Under 37 CFR 1.47(a), in a Decision dated June 16, 2005, be dismissed.

Pursuant to 37 CFR 1.47(a), enclosed herewith is a Combined Declaration/Power of Attorney executed by Mr. Elms in compliance with 37 CFR 1.63. Mr. Elms thus joins this application, submits this statement and request, and a Combined Declaration and Power of Attorney (Ex. B) enclosed herewith.

Mr. Elms's position is straightforward: only Mr. Elms and Mr. David K. Black are the co-inventors of the Application (Ex. A ¶¶ 3-4). While Mr. Elms is the primary inventor of the invention claimed in the Application, Mr. Black contributed some novel content related to security and/or encryption (Ex. A ¶¶ 3-4) that appears to be reflected in currently-pending dependent claims 39 and 41. The remaining named inventors, Mr. Fremaux, Mr. Almond, and Mr. Malik, however, did not contribute novel ideas. These men contributed background, well-known information related to elections and processes, or implemented the invention as previously conceived, but did not contribute novel ideas,

let alone novel ideas reflected in the claims (Ex. A ¶¶ 5-8). In particular, Mr. Fremaux provided background information regarding elections and how they are run (Ex. A ¶ 6). Mr. Malik was knowledgeable regarding election processes and served as a sounding board for Mr. Elms so that Mr. Elms could confirm that his design comported with election processes (Ex. A ¶ 7). Mr. Almond was knowledgeable regarding security issues, but the security aspects of the invention were already designed by the time Mr. Almond became involved with the project related to the invention (Ex. A ¶ 8). Mr. Almond wrote software code and provided oversight during the implementation of the security aspects of the invention, but did not contribute inventive concepts (Ex. A ¶ 8). While Mr. Fremaux, Mr. Malik, and Mr. Almond contributed well-known information that Mr. Elms used, and/or worked on the project to implement the invention, these efforts do not make one an inventor.


Also, the Petition Under 37 CFR 1.47(a) dated November 4, 2004 (Ex. C) and the accompanying Declaration by Mr. David Nelson dated November 4, 2004 (Ex. D) are contradicted by Mr. Elms' past and present willingness to sign documents related to the Application. The Petition asserts that Mr. Elms "refuses to sign the Joint Declaration and Power of Attorney." Mr. Elms is ready, willing, and able, and has always been so, to execute a Declaration that reflects the accurate list of inventors. Indeed, the very letter (Ex. E) cited in the Petition (Ex. C) to support the position that Mr. Elms allegedly refused to sign the Joint Declaration and Power of Attorney specifically states that Mr. Elms was not able to sign the Declaration at that point in time due to the inaccurate inventorship list. The Declaration of Mr. Nelson (Ex. D) reads in ¶¶ 6-7 that Mr. Elms refused to execute the Declaration and Power of Attorney without payment of \$15,000. The letter (Ex. E) cited in ¶6 of the Nelson Declaration (Ex. D), however, requests reasonable compensation for review of the Application, which is a necessary task before signing a Declaration asserting that the signing party has "reviewed and understand(s) the contents of the (Application), including the claims" as required by the Declaration for Patent Application submitted for this Application. Mr. Elms did not request money in exchange for signing, but reasonable compensation for time to review the Application for inaccuracies and to comply with his obligations in signing a Declaration for a patent application.

**Express Mail No. EV475168646 US**  
**Date of Deposit: January 13, 2006**

Mr. Elms thus requests that the granting of the Petition Under 37 CFR 1.47(a) be dismissed. Mr. Elms was not unwilling to sign a declaration, just unwilling to sign an inaccurate declaration. Indeed, Mr. Elms has signed an accurate declaration (Ex. B). Further, the inventorship list as it currently stands is inaccurate.

The Patent Office is invited to contact Mr. Elms' attorney at the numbers/address provided below with any questions.

Respectfully submitted,

  
\_\_\_\_\_  
Shane H. Hunter, Reg. No. 41,858  
Kyle Turley, Reg. No. 57,197  
Attorneys for Applicant  
Mintz, Levin, Cohn, Ferris,  
Glovsky and Popeo, P.C.  
One Financial Center  
Boston, MA 02111  
Telephone: (617) 542-6000  
Facsimile: (617) 542-2241  
**Customer No. 30623**

Date: January 13, 2006

EXHIBIT A



Attorney Docket No. 23906-002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter Elms et al.  
Serial No.: 10/743,321  
Filed: December 23, 2003  
For: SECURE ELECTRONIC REGISTRATION AND VOTING SOLUTION  
Examiner: Sheikh, A.  
Art Unit: 2131

---

Mail Stop Petition  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

DECLARATION OF PETER ELMS UNDER 37 CFR 1.47(a)

1. This declaration is being made to dispute the list of inventors provided in the above-identified patent application (the Application) in a Petition Under 37 CFR 1.47(a) dated November 4, 2004, and a Request for Reconsideration of Petition Under 37 CFR 1.47(a) dated March 21, 2005.
2. I, Peter M. Elms, was employed by Accenture Inc. from August 1, 2000 to April 15, 2003 as a Technical Architect Associate Partner. During my employment, I invented the claimed invention of all the independent claims, namely claims 1, 18, 19, 20, 21, 24, 31, and 36, of the Application. Claims 1-41 are currently pending in the Application. A copy of the pending claims is attached hereto as Exhibit A. As shown in Exhibit A, claims 2-14 and 31, 16-22 and 32-33, and 24-30 and 34, respectively, depend from independent claims 1, 15, and 23.
3. Initially, I asserted that I was the sole inventor of the invention described in the Application (the Invention). After reviewing the claims submitted to the United States Patent Office, and discussing with my patent attorney, Mr. Shane H. Hunter, the requirements of an inventor and the pending claims, I agree that I am a joint inventor of the Invention with Mr. David K. Black only. While I am the inventor of the vast majority of the Invention, Mr. Black is

also an inventor.

4. Mr. David K. Black, who to my knowledge was also an employee of Accenture Inc., assisted me with the Invention. Mr. Black was knowledgeable regarding security/encryption techniques and contributed to novel aspects of the Invention in this area. In particular, I believe that Mr. Black is a co-inventor of dependent claims 39 and 41.

5. The list of inventors provided on the Declaration for Patent Application submitted with the Request for Reconsideration of Petition Under 37 CFR 1.47(a) dated March 21, 2005 is incorrect. This Declaration incorrectly lists Mr. Emmett H. Fremaux, Mr. Niten Malik, and Mr. Carl Almond as inventors. Neither Mr. Fremaux, Mr. Malik, nor Mr. Almond contributed any novel concept to the Invention.

6. Mr. Fremaux, who to my knowledge was employed by Accenture Inc. as a Vice President, Business Development at Accenture eDemocracy Services, assisted me with the Invention with non-novel contributions. Mr. Fremaux, as the former executive director of the District of Columbia Board of Elections and Ethics was knowledgeable regarding the running of elections and provided general background information regarding the running of elections. The information the Mr. Fremaux provided was general, public information that I used to help ensure that the Invention comported with standard election practices. Mr. Fremaux's information did not affect the design of the Invention in any novel way.

7. Mr. Malik, who to my knowledge was employed by Accenture Inc. as a Process Manager, also assisted me with the Invention with non-novel contributions. Mr. Malik was knowledgeable regarding election processes. I used Mr. Malik as a sounding board, providing him with my ideas for my invention for confirmation that the Invention would comport with standard election processes. Mr. Malik's information did not affect the design of the Invention in any novel way.

8. Mr. Almond, who to my knowledge was employed by Avanade Inc. and subcontracted to

Accenture Inc. as a security engineer, also assisted me with the Invention with non-novel contributions. Mr. Almond was knowledgeable regarding security techniques issues. By the time that Mr. Almond participated in the team involved in implementing the Invention, however, the security aspects of the Invention had already been designed. Mr. Almond wrote software code for and provided oversight of the implementation of the security aspects of the invention, but did not add novel aspects of the design of the Invention in doing so. Mr. Almond's work, while entailing significant work, did not affect the design of the Invention in any novel way.

9. I, Peter M. Elms, hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by a fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Application or any patent issued thereon.

**SIGNATURE:**

Full name of joint inventor: Peter Elms

Inventor's signature: \_\_\_\_\_

Date: 01/10/2006

Residence: 4215 Oakridge Lane, Chevy Chase, MD, 20815

Citizenship: Citizen of the United States

TRA 2100397

## EXHIBIT B

Express Mail Label No. EV475168646 US  
Date of Deposit: January 13, 2006

Attorney Docket No.: 23906-002



### COMBINED DECLARATION AND POWER OF ATTORNEY FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a utility patent is sought on the invention entitled:

#### SECURE ELECTRONIC REGISTRATION AND VOTING SOLUTION

the specification of which was filed on December 23, 2003, bearing Serial No. 10/743,321.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information that is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, §119(a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT International application designating at least one country other than the United States listed below and have also identified below any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

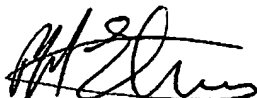
Appln. Number	Country (if PCT, so indicate)	Filing Date (dd/mm/yy)	Priority Claimed	
			Yes	No
			<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>
			<input type="checkbox"/>	<input type="checkbox"/>

I hereby claim the benefit under Title 35, United States Code, § 119(e) or §120 of any United States application(s), or §365(c) of any PCT International application(s) designating the United States of America listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

Application No. (U.S.S.N.)	Filing Date (dd/mm/yy)	Status (Patented, Pending, Abandoned)
60/444,885	February 5, 2003	Abandoned

I hereby appoint the attorneys and/or agents associated with Mintz Levin Cohn Ferris Glovsky & Popeo, **Customer Number 30623** to prosecute this application and any renewals, revivals, reissues, reexaminations, extensions, continuations and divisions thereof any substitute applications therefore, and to transact all business in the Patent and Trademark Office connected therewith.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or patent issued thereon.



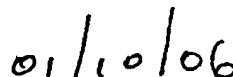
**Inventor's Signature:**

Full Name of Inventor: Peter Michael Elms

Citizenship: USA

Residence: 4215 Oakridge Lane, Chevy Chase, MD 20815

Post Office Address: Same



Date

**Inventor's Signature:**

Full Name of Inventor: David K. Black

Citizenship: USA

Residence: 2628 Garfield Street, NW, Washington, DC 20008

Post Office Address: Same

Date



Express Mail No. EV475168646US  
Date of Deposit: January 13, 2006

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/743,321                      Confirmation No.: 5565  
Applicant(s) : Peter ELMS  
Filed : December 23, 2003  
TC/A.U. : 3623  
Examiner : Not Yet Assigned  
  
Docket No. : 86769-0026  
Customer No. : 30398

PETITION UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents  
Attn: Box: Missing Parts  
Washington, D.C. 20231

Dear Sir:

Applicants hereby petition under 37 C.F.R. §1.47(a) to file the present application without the signature of one (1) of the inventors on an Oath or Declaration. Submitted herewith is a Declaration for Patent Application identifying the present application by Application number and by filing date. The Joint Declaration and Power of Attorney is signed by all except one of the inventors (David K. Black, Emmett H. Fremaux, Niten Malik and Carl Almond) and has a blank signature block for the non-signing inventor (Peter Elms). In accordance with MPEP §409.03(a)(A), this Declaration for Patent Application may be treated as having been signed by all the available inventors on behalf of the nonsigning inventors.

Further attached herewith is a Declaration in Support of the Petition under 37 C.F.R. §1.47(a) [hereafter the "Declaration"] describing the diligent efforts made to contact the non-signing inventor, Mr. Elms, who refuses to sign the Joint Declaration and Power of Attorney. As further described in the Declaration, Mr. Elms was an employee of the assignee of the present application during the time of invention and is under a legal obligation to sign an Oath or Declaration.

11/05/2004 GWORDDF1 00000104 501349 10743321

01 FC:1460 130.00 DA

Petition Under 37 C.F.R. 1.47(a) dated November 4, 2004  
Notice to File Missing Parts dated April 5, 2004

The last known address for the non-signing inventor, Mr. Elms, is:

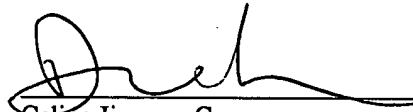
4215 Oakridge Lane  
Chevy Chase, Maryland 20815

Also submitted herewith is a check for the Petition fee of \$130 as specified in 37 CFR §1.17(h). Please charge any deficiencies and credit any overpayment to the Deposit Account No. 50-1359 of the undersigned.

Respectfully submitted,

Dated: November 4, 2004

By:

  
Celine Jimenez Crowson  
Registration No. 40,357

David D. Nelson  
Registration No. 47,818

**Hogan & Hartson, L.L.P.**  
555 13th St., N.W.  
Washington, DC 20004  
Telephone: (202) 637-5497  
Facsimile: (202) 637-5910  
Customer No. 30398



Express Mail No. EV4751686460S  
Date of Deposit: Jan. 13, 2006

EXHIBIT D

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/743,321  
Applicant(s) : Peter ELMS  
Filed : December 23, 2003  
TC/A.U. : 3623  
Examiner : Not Yet Assigned

Confirmation No.: 5565

Docket No. : 86769-0026  
Customer No. : 30398

DECLARATION IN SUPPORT OF PETITION UNDER 37 C.F.R. §1.47(a)

Commissioner for Patents  
**Box: Missing Parts**  
Washington, D.C. 20231

Sir:

In support of a Petition Under 37 C.F.R. 1.47(a) for the above-referenced patent application, I, David D. Nelson, declare that I am a registered Patent Attorney, Registration No. 47,818, that I represent Accenture Global Services GmbH in connection with the preparation and prosecution of the present patent application, and that I am authorized to make the following statements:

(1) Accenture Inc. is a wholly owned subsidiary of Accenture Global Services GmbH. Accenture Global Services GmbH is a corporation of Switzerland and principally located at Geschäftshaus Herrenacker 15, 8200 Schaffhausen, Switzerland.

(2) Mr. Peter Elms was an employee of Accenture Inc. During his employment period, Mr. Elms, as part of his employment duties, participated in the development of the subject matter of the above-referenced patent application.

(3) After Mr. Elms left Accenture Inc, he retained separate patent counsel, as evidenced by letter of December 12, 2003 from James G. Gatto Esq., attached hereto as Appendix 1.

(4) According to Accenture, Inc.'s personnel records and as confirmed in a telephone conversation with Mr. Gatto, Mr. Elms' current correspondence address is 4215 Oakridge Lane, Chevy Chase, Maryland 20815.

(5) I forwarded to Mr. Elms, through his attorney Mr. Gatto, a letter forwarding a Declaration document and a copy of the complete application as filed. A copy of this letter is attached hereto as Appendix 2.

(6) On June 10, 2004, I received a letter from Mr. Gatto confirming that Mr. Elms had received the letter of May 18, 2004 containing the attached Declaration document and the copy of the complete application as filed. Mr. Gatto further indicated that Mr. Elms was refusing to sign the application without further compensation. A copy of this letter is attached hereto as Appendix 2.

(7) On or approximately October 25 2004, I spoke with an associate of Mr. Gatto, who indicated that Mr. Elms would not execute the Declaration document unless Accenture Inc. paid an exorbitant fee of \$15,000.

(9) I have received no other response or correspondence from Mr. Elms or his counsel. I make this declaration to prevent abandonment of the subject patent application as Mr. Elms is required to execute the Declaration and Power of Attorney but has not yet done so.

Application No. 10/743,321

Declaration in Support of Petition under 37 C.F.R. 1.47(a) dated November 4, 2004

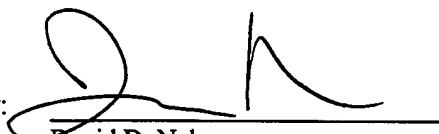
Notice to File Missing Parts dated April 5, 2004

I further declare that all statements made herein of my own knowledge are true; that all statements made on information and belief are believed to be true; that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001; and that such willful false statements may jeopardize the validity of the application or document or any resulting registration resulting therefrom.

Respectfully submitted,

Dated: November 4, 2004

By:

A handwritten signature in black ink, appearing to be "D. Nelson", written over a horizontal line.

David D. Nelson

Registration No. 47,818

**Hogan & Hartson, L.L.P.**

555 13th St., N.W.

Washington, DC 20004

Telephone: (202) 637-5497

Facsimile: (202) 202-637-5910

Customer No. 30398

EXHIBIT E

MINTZ LEVIN  
COHN FERRIS  
GLOVSKY AND  
POPEO PC

Reston  
Boston  
New York  
Washington  
New Haven

12010 Sunset Hills Road  
Suite 900  
Reston, Virginia 20190-5839  
703 464 4800  
703 464 4895 fax  
www.mintz.com

James G. Gatto  
Member

Direct dial 703 464 8182  
jggatto@mintz.com

June 9, 2004

**BY FEDERAL EXPRESS**

Celine J. Crowson, Esquire  
Hogan & Hartson, L.L.P.  
Columbia Square  
555 Thirteenth Street, NW  
Washington, DC 20004-1109

HOGAN & HARTSON L.L.P.

JUN 10 2004

IP DOCKETING DEPT.

Re: U.S. Patent Application Serial No. 10/743,321  
Filed: December 23, 2003  
For: "SECURE ELECTRONIC REGISTRATION AND VOTING SOLUTION"  
Your Reference: 86769-0026US  
Our Reference: 23906-002

Dear Ms. Crowson:

Further to your letter of May 18, 2004, Mr. Elms is willing to sign the Declaration, subject to resolution of various issues, some of which are addressed below. I suggest that we arrange for a telephone conversation to discuss the issues further.

Regarding the Declaration, Mr. Elms notes that the information listed for him is not correct. He is in fact a citizen of Canada. Furthermore, Mr. Elms is not able to sign the Declaration at this point because he believes he is the sole inventor of the subject matter claimed therein. As you recall, Mr. Elms is the sole inventor listed in the provisional application from which this utility application claims priority. The claims of the utility application appear to be supported by the contributions made by Mr. Elms alone. Please provide an explanation of why David K. Black, Emmett H. Fremaux, Niten Malik and Carl Almond are added to the utility application.

Furthermore, regarding a review of the content of the patent application for accuracy, completeness and compliance with 35 U.S.C. Section 112 (including satisfaction of the best mode requirement), Mr. Elms is willing to undertake the necessary review provided he is given reasonable compensation for his time. Please let us know if your client is willing to agree to reasonable compensation, and if so, please provide us a proposal that we may present to Mr. Elms.

Celine Crowson, Esquire

June 9, 2004

Page 2

Mr. Elms also wants to make sure that when he signs, he will be ensured that all prior art and other information of which he is aware will be submitted to the United States Patent and Trademark Office to comply with the duty of disclosure. Please confirm that, subject to the foregoing, if Mr. Elms signs, you will submit all of the information he provides to the USPTO.

I look forward to your response, and to discussing this matter further.

Sincerely,

*James G. Gatto / bcb*  
James G. Gatto

JGG